IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)	Group Art Unit: To Be Assigned
	)	
ADAMS *et al.*	)	Examiner: To Be Assigned
	)	
Continuation Application of: Serial No. 09/365,121	)	Atty. Docket No. GP100-03.CN1
	)	
Filed: May 29, 2001	)	
	)	
For: DECOY PROBES	)	

PRELIMINARY AMENDMENT

Box Patent Application
Commissioner for Patents
Washington, D.C. 20231

Sir:

In connection with the above-captioned continuation application, kindly enter the following preliminary amendments and consider the following remarks.

Amendments

IN THE SPECIFICATION:

Kindly substitute the following for page 1, lines 5-6, of the specification:

This application is a continuation of application Serial No. 09/365,121, filed July 30, 1999, the contents of which are hereby incorporated by reference herein, which claims the benefit of U.S. Provisional Application No. 60/094,979, filed July 31, 1998.

IN THE CLAIMS:

Please cancel claims 19-33 without prejudice.

Kindly substitute and add claims as follows:

1. (Amended) A purified decoy probe comprising:

a first nucleotide base recognition sequence region, wherein said first region binds to an RNA polymerase; and

an optionally present second nucleotide base recognition sequence region,

provided that if said first region is nucleic acid, then said second region is either directly joined to the 5' end of said first region or is joined to the 3' end or 5' end of said first region by a non-nucleotide linker, wherein said optionally present second region is present if said first region can be used to produce a functional double-stranded promoter sequence using a complementary oligonucleotide,

further provided that if said first region is nucleic acid which can be used to produce said functional double-stranded promoter sequence using said complementary oligonucleotide, then said decoy probe does not have a nucleic acid sequence greater than about 10 nucleotides in length joined directly to the 3' end of said first region and said decoy probe does not have a 3' end that can participate in a polymerase reaction.

2. (Amended) The probe of claim 1, wherein said first region is nucleic acid.

7. (Amended) The probe of claim 6, wherein said probe consists of 35 to 70 independently selected nucleotides and said one or more blocking groups.

11. (Amended) A purified decoy probe comprising:

a first nucleotide base recognition sequence region, wherein said first region has at least 35% sequence similarity to an RNA polymerase promoter sequence; and

an optionally present second nucleotide base recognition sequence region,

provided that if said first region is nucleic acid, then said second region is either directly joined to the 5' end of said first region or is joined to the 3' end or 5' end of said first region by a non-nucleotide linker, wherein said optionally present second region is present if said first

region can be used to produce a functional double-stranded promoter sequence using a complementary oligonucleotide,

further provided that if said first region is nucleic acid which can be used to produce said functional double-stranded promoter sequence using said complementary oligonucleotide, then said decoy probe does not have a nucleic acid sequence greater than about 10 nucleotides in length joined directly to the 3' end of said first region and said decoy probe does not have a 3' end that can participate in a polymerase reaction.

12. (Amended) The probe of claim 11, wherein said first region is nucleic acid.

15. (Amended) The probe of claim 14, wherein said probe consists of 35 to 70 independently selected nucleotides and said one or more blocking groups.

34. (New) The probe of claim 1, wherein said probe contains a region of self-complementarity.

35. (New) The probe of claim 11, wherein said probe contains a region of self-complementarity.

* * * * *

Remarks

Claims 1, 2, 7, 11, 12 and 15 have been preliminarily amended herein in a manner fully supported by the specification, and claims 19-33 have been canceled without prejudice to the prosecution of the subject matter of these claims in this or a future continuing application.

Claims 34 and 35 are newly added and depend from claims 1 and 11, respectively. New claims 34 and 35 are supported in the specification at, for example, page 10, lines 10-12.

The specification has been amended herein to update the continuing data. A marked up copy of the amendments to the specification and claims is being provided herewith in accordance with the provisions of 37 C.F.R. § 121(b) & (c).

Applicants initially observe that the claims specify that the recited second nucleotide base sequence region is optional unless the first nucleotide base sequence region can be used to produce a functional double-stranded promoter sequence using a complementary oligonucleotide. Thus, in view of the claimed subject matter allowed in parent application Serial No. 09/365,121 ("the parent application"), the primary issue remaining for the Examiner to address in the present case is whether the art discloses or suggests a first nucleotide base recognition sequence which binds to an RNA polymerase but which does not produce a functional double-stranded promoter sequence using a complementary oligonucleotide. Applicants submit that the Examiner in the parent application failed to identify any art disclosing or suggesting, alone or in combination, such a structure. Therefore, in the absence of relevant new art in the present case, Applicants submit that the claims now under consideration are fully patentable.

Applicants further note that while the claims of the instant application and claims of the parent application are directed to overlapping subject matter, the claims of the instant application are not directed to the "same invention" as the claims of the parent application. Accordingly, Applicants submit that it would be inappropriate for the Examiner to issue a same invention rejection in this case. *See* MPEP § 804 II.A. at 800-16 (7th ed., Rev. 1, Feb. 2000) ("A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent.").

Conclusion

Applicants submit that the subject application is in condition for allowance and Notice to that effect is respectfully requested.

Certificate of Express Mailing

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is being deposited on the date indicated below with the U.S. Postal Service as express mail (Express Mail No. ET620464619US) addressed to Box Patent Application, Commissioner for Patents, Washington, D.C. 20231.

Respectfully Submitted,

Date: May 29, 2001 By: _____

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Marked Up Copy of Amendments

IN THE SPECIFICATION:

The specification has been amended at page 1, lines 5-6, as follows:

This application is a continuation of application Serial No. 09/365,121, filed July 30, 1999, the contents of which are hereby incorporated by reference herein, which claims the benefit of U.S. Provisional Application No. 60/094,979, filed July 31, 1998[, the contents of which are hereby incorporated by reference herein].

IN THE CLAIMS:

Claims 19-33 have been canceled without prejudice, claims 34 and 35 are newly added, and claims 1, 2, 7, 11, 12 and 15 have been amended as follows:

1. (Amended) A purified decoy probe comprising[,]:

a first nucleotide base recognition sequence region, wherein said first region binds to an RNA polymerase[,]; and

an optionally present second nucleotide base recognition sequence region,

provided that if said first region is nucleic acid, then said second region is either directly joined to the 5' end of said first region or is joined to the 3' end or 5' end of said first region by a non-nucleotide linker, wherein said optionally present second region is present if said first region can be used to produce a functional double-stranded promoter sequence using a complementary oligonucleotide,

further provided that if said first region is nucleic acid which can be used to produce said functional double-stranded promoter sequence using said complementary oligonucleotide, then said decoy probe does not have a nucleic acid sequence greater than about 10 nucleotides in length

joined directly to the 3' end of said first region and said decoy probe does not have a 3' end that can participate in a polymerase reaction.

2. (Amended) The probe of claim 1, wherein said first region is nucleic acid[, said second region is present and directly joined to the 5' end of said first region, and said probe does not have a nucleotide base sequence greater than 10 nucleotides in length joined directly to its 3' end].

7. (Amended) The probe of claim 6, wherein said probe consists of 35 to 70 independently selected nucleotides[,] and said one or more blocking groups[, and said second region which comprises a nucleotide base sequence at least 10 nucleotides in length].

11. (Amended) A purified decoy probe comprising[,]:

a first nucleotide base recognition sequence region, wherein said first region has at least 35% sequence similarity to an RNA polymerase promoter sequence[,]; and

an optionally present second nucleotide base recognition sequence region,

provided that if said first region is nucleic acid, then said second region is either directly joined to the 5' end of said first region or is joined to the 3' end or 5' end of said first region by a non-nucleotide linker, wherein said optionally present second region is present if said first region can be used to produce a functional double-stranded promoter sequence using a complementary oligonucleotide,

further provided that if said first region is nucleic acid which can be used to produce said functional double-stranded promoter sequence using said complementary oligonucleotide, then said decoy probe does not have a nucleic acid sequence greater than about 10 nucleotides in length joined directly to the 3' end of said first region and said decoy probe does not have a 3' end that can participate in a polymerase reaction.

12. (Amended) The probe of claim 11, wherein said first region is nucleic acid[, said second region is present and directly joined to the 5' end of said first region, and said probe does not have a nucleotide base sequence greater than 10 nucleotides in length joined directly to its 3' end].

15. (Amended) The probe of claim 14, wherein said probe consists of 35 to 70 independently selected nucleotides[,] and said one or more blocking groups[, and said second region which comprises a nucleotide base sequence at least 10 nucleotides in length].